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Paper No. 18

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In re Application of: Yoram Cedar et al.)	DECISION ON PETITION TO
Application No. 09/641,023)	MAKE SPECIAL UNDER 37
Filed: August 18, 2000)	C.F.R. §1.59(b) AND M.P.E.P.
For: MULTIPLE REMOVABLE NON-)	§§724.05 AND 724.06 TO
VOLATILE MEMORY CARDS)	EXPUNGE AND RETURN
SERIALLY COMMUNICATING)	DOCUMENTS
WITH A HOST)	

This is a decision on the petition under 37 CFR 1.59(b), filed to expunge information submitted pursuant to MPEP 724.02.

Petitioner requests that two documents respectively referred to as "Redacted SD Specification 1.0" and "Redacted Supplementary Notes" filed under seal in accordance with M.P.E.P. §724.02 and referenced in the Information Disclosure Statement filed on October 14, 2003 be expunged from the record after they have been reviewed by the examiner. Petitioner states that the information contains trade secret and proprietary material. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The petition is **DISMISSED**.

Relevant parts of the M.P.E.P. which relate to this petition are reproduced below with emphasis added to key phrases:

724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information ... If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

...

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that *the information has not been otherwise made public*;

(C) a *commitment* on the part of the petitioner *to retain such information* for the period of any patent with regard to which such information is submitted;

... it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process.

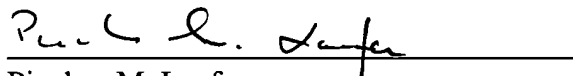
A decision on the petition is *premature* because the application has not been allowed or abandoned. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

Furthermore, the petition is deficient in the following aspects: Petitioner does not state that the information has otherwise not been made public as required in (B) above; and petitioner does not commit to retain the information as required by (C) above. Accordingly, the petition to expunge is **DISMISSED**.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." *Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information.* No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be returned to applicant.

The application file is being forwarded to the Examiner for appropriate action.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.



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